

REMARKS

The Office Action of December 3, 2003 was improperly issued as a final Office Action following the Examiner's removal of the present case from appeal. In a phone conference with the Applicant's representative on May 17, 2004, the Examiner acknowledged that the finality of the Office Action of December 3, 2003 was improper and indicated that the finality of the Office Action is withdrawn. The Applicant gratefully acknowledges withdrawal of this finality.

Claim Rejections

Claims 1-6 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,466,692 to Sonoda ("Sonoda") in view of U.S. Patent No. 6,595,788 to Harper, Jr. *et al.* ("Harper, Jr. *et al.*").

Claims 1-6 of the present application are believed to be in condition for allowance for at least the reason that the cited references do not support a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

***Prima Facie* Obviousness**

The MPEP states:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations."

MPEP at § 2143.

There is No Sufficient Suggestion or Motivation to Combine the Sonoda and Harper, Jr. References

The Office Action cites no suggestion or motivation to combine the teachings of the Sonoda and the Harper, Jr. *et al.* patents, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.” MPEP § 2143. As stated in MPEP § 2143.01, the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. The MPEP goes on to state that “the mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *Id.* (emphasis in original).

The Office Action cites nothing in either Sonoda or Harper, Jr. *et al.* that suggests the desirability of combining these references. Neither of the cited patents mentions the problem of incomplete terminal cutting caused by the structure of the terminals. And neither reference suggests that the structure of a terminal might facilitate complete cutting of terminals from a carrier strip, as claimed.

Harper, Jr. *et al.* mentions that interconnection sections between connectors “allow for relatively easy cutting or severing of the interconnection sections 54 to form the multiple strips 26.” Harper, Jr. *et al.* at col. 4, lines 36-38. This is a mere statement of the purpose of the interconnection sections and not a suggestion that any other feature of Harper, Jr. *et al.* might aid in the cutting of terminals from a carrier strip. Further, this statement does not amount to a suggestion that the Harper, Jr. *et al.* structure might be combined with another structure to facilitate the complete cutting of terminals from a carrier strip. Nothing in either reference

suggests that the shape of a terminal itself might facilitate cutting a terminal completely from a carrier strip.

When applying 35 U.S.C. § 103, references must suggest the desirability and thus the obviousness of making the combination. Also, the references must be viewed without the benefit of impermissible hindsight vision. MPEP § 2141, *citing Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). Neither of the cited references addresses the desirability of avoiding faulty termination separation, and no suggestion exists in the references of the desirability of making a combination in which a squared shoulder facilitates cutting connectors completely from a carrier strip, as claimed. Because neither the Office Action nor the cited references indicate a suggestion or motivation in the prior art to combine the references, the Applicant submits that no *prima facie* case of obviousness exists. Claims 1-6 are thus believed to be in condition for allowance.

The Prior Art References Do Not Teach or Suggest all of the Claim Limitations

Even if the desirability of combining Sonoda and Harper, Jr. *et al.* were suggested, such a combination would still lack the claimed feature of a “squared shoulder facilitating cutting said terminal completely from said carrier strip,” as claimed in claim 1, or the feature of a “squared shoulder facilitating the complete removal of said terminals from said carrier strip” as claimed in claim 4. Because a *prima facie* case of obviousness requires that all of the claim limitations must be taught or suggested by the prior art, and further because all of the words of a claim must be considered in judging the claim’s patentability, no *prima facie* case of obviousness is supported by the proposed combination of Sonoda and Harper, Jr. *et al.* MPEP § 2143.03.

Harper, Jr. *et al.* does not disclose any use of a shoulder for facilitating cutting or removing terminals completely from a carrier strip. As an initial matter, no reference is made in Harper, Jr. *et al.* to the complete cutting of a terminal from a carrier strip. Rather, as shown in FIG. 2 of Harper, Jr. *et al.*, the contacts 27 of Harper, Jr. *et al.* are provided on contact strips 26. The contact strips 26 are adapted for insertion into housing pieces such as the housing piece 24 of Fig. 4. Harper, Jr. *et al.* does not address the cutting of a terminal completely from a carrier strip; at most a contact of the Harper, Jr. *et al.* apparatus is cut from a contact strip at only one side. Thus, Harper, Jr. *et al.* does not address the cutting of terminals “completely from said carrier strip” or the “complete removal of said terminals from said carrier strip,” as claimed, respectively, in independent claims 1 and 6 of the present application.

The Office Action states that Harper, Jr. *et al* discloses “the concept of having a generally squared shoulder (54), the squared shoulder (54) facilitating cutting the connectors (40) completely from the carrier strip (Fig. 2).” Office Action at page 4. The Applicant respectfully submits that no such disclosure is found in Harper, Jr. *et al.*. The portion referred to in the Office Action as a “squared shoulder (54)” is termed the “interconnection section 54” in the Harper, Jr. *et al.* disclosure. *See Col. 4, lines 15-16.* Rather than being a “squared shoulder” as stated in the Office Action, the interconnection sections 54 of Harper, Jr. *et al.* are roughly analogous to the links 26 of the carrier strip 12 of the present invention, as shown in FIG. 2 of the present application. While the main sections 52 of a body 40 of a strip 26 of Harper Jr. *et al.* appear to have flat surfaces, there is no indication in Harper Jr. *et al.* that any feature approximating a squared shoulder facilitates the complete cutting or removal of terminals from a carrier strip as claimed in the present application. No such teaching or suggestion is found in Sonoda, either. Because these claim limitations are not found in either Sonoda or Harper Jr. *et al.*, the Applicant

respectfully submits that independent claims 1 and 4 are in condition for allowance and requests action toward that end.

Dependent claims 2, 3, 5, and 6 are believed to be in condition for allowance for at least the reason that they depend from allowable base claims.

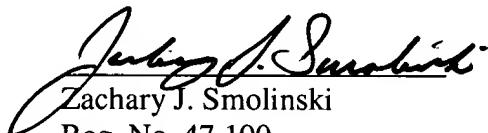
New Claim

Claim 11, directed to a terminal disposed on a carrier strip, is new and is believed to be in condition for allowance.

The present response is being submitted within the three-month extension period for response to the Office Action. The Commissioner is authorized to charge the extension fee of \$950 for an extension for response within the third month to Deposit Account Number 16-0228. The Commissioner is further authorized to charge any other fee deemed necessary, except the issue fee, to deposit account number 16-0228.

Respectfully submitted,

Dated: May 25, 2004



Zachary J. Smolinski
Reg. No. 47,100
Attorney for Applicant

Panduit Corp.
Legal Department - TP12
17301 S. Ridgeland Avenue
Tinley Park, Illinois 60477-3091
(708) 532-1800, Ext. 1302